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09/990,402	11/21/2001	William K. Slate II	AAA-003	3669

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EXAMINER

AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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10/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/990,402

Applicant(s)

SLATE ET AL.

Examiner

Evans Augustin

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/13/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44, 60-103 and 119-162 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44, 60-103 and 119-162 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment

1. This office action is response to an interview, which was held on 09/07/07, during which the Examiner agreed to withdraw the finality of office action mailed on 05/21/2007. Claims 1-12, 15-44, 60-71, 47-103, and 119-130 and 133-162 are pending.

Claim Interpretation

2. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.

3. It should also be noted that, in the office action that:

- A. Items in the rejection that are in quotation marks are claimed language/limitations.
- B. Passages in prior art references may be mere rephrasing/rewording of claimed limitations, but the implicit/explicit meaning of the references vis-à-vis the claimed limitation remains intact.
- C. Functional recitation(s) using the word “for” or other functional terms (*e.g.* “for the dispute management application” as recited in claim 5) have been considered but given less patentable weight¹ because they fail to add any steps and are thereby

¹ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

- D. Limitations that recite the purpose of a process or the intended use of a structure are generally not given any patentable weight. Patentable weight is therefore given to the actual process steps or structural limitations.
- E. Word(s) that are separated by "/" are being examined as being synonymous or equivalent.
- F. With regard to the limitation of "assigning a case manager, who is a~ entity a user other than the user or the at least one party, to manage the dispute management process using a second computer in response to receiving the indication at the first computer, wherein managing the dispute management process comprises guiding the user and the at least one party through [[a]] the dispute resolution process ", the USPTO will give less patentable to the aspect of "managing the dispute management process comprises guiding the user and the at least one party through [[a]] the dispute resolution process" because the language does not further the limitation of assigning a case manager.

- G. The USPTO interprets claim limitations that contain statement(s) such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.
- H. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.
- I. Any official notices taken by the USPTO that are not adequately traversed by applicant will be taken to be admitted prior art.
- J. The USPTO interprets common computer related words that are not lexicographically defined, in accordance to Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997². The USPTO also uses published patent applications and

² Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

issued patents as well, for meanings of common computer related words that are not lexicographically defined. Accordingly, the word module is: In programming, a collection of routines and data structures that performs a particular task or implements a particular abstract data type. Modules usually consist of two parts: an interface, which lists the constants, data types, variables, and routines that can be accessed by other modules or routines, and an implementation, which is private (accessible only to the module) and which contains the source code that actually implements the routines in the module. See also abstract data type, information hiding, Modula-2, modular programming. 2. In hardware, a self-contained component that can provide a complete function to a system and can be interchanged with other modules that provides similar functions.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-12, 15-44, 60-71, 47-103, 119-130 and 133-162 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (U.S 6,766,307), in view of Landry et al. (U.S 20030014265).

6. As per claims 1-12, 15-44, 60-71, 47-103, and 119-130 and 133-162, Israel et al. discloses a system and method for providing dispute resolution management. The system utilizes software packages (application) (column 28, lines 39-50), and hardware combination (column 8, lines 48-57) for input (keyboard) and display (monitor), as resources to achieve its desired results. The system can:

A. Receive dispute resolution management request from users (column 2, line 44)

("receiving an indication from a user to file a claim against at least one party using a first computer, wherein the claim comprises a request for a dispute management process between the user and the at least one party")

B. Provide the options/features of the dispute resolution management from users (column 3, lines 26-30) ("providing the user with a first plurality of dispute management features at the first computer in response to receiving the indication at the first compute")

C. The system has a program manager, which is equivalent to the case manager in question, that can include a plurality of selectable actions such as, for example and not limited hereby, adding users, modifying existing user data, transferring active cases from one user to another, activating users, modifying account registration data, browsing all disputes, generating detailed dispute reports, generating summary reports of disputes, browsing dispute resolution cases, as well as other actions which are used by a manager of non-judicial dispute resolutions, and any combination of one or more of the foregoing (col. 3, lines 13-24) ("assigning a case manager, who is a~ entity a user other than the user or the at least one party, to manage the dispute management process using a second computer in response to receiving the indication at the first computer, wherein managing

the dispute management process comprises guiding the user and the at least one party through [[a]] the dispute resolution process"), ("providing the case manager with a second plurality of dispute management features at the second computer")

- D. The Program Manager will be notified that the dispute(s) have been successfully transferred from one Program User to another (col. 13, lines 23-25). Therefore the program is entity that is different from the program users i.e., conflicting parties. The program manager is a user that has access to the system (col. 11, lines 60-62). ("notifying the case manager of the assignment")
- E. Additionally, the program manager interacts with management module (col. 12, lines 7-15). The management module (a self-contained component that can provide a complete function to a system and can be interchanged with other modules that provides similar functions) is configured to transmit notices to each party to a dispute regarding a change in the status of the dispute, the input of additional data in relation to the dispute, the results of a query of the data contained within management module, or any other information relating to the dispute and/or for transmitting the dispute resolution data to the appropriate entity for mediation and/or arbitration (col.10, lines 13-20), in other words, managing the dispute resolution process ("wherein the second plurality of features comprises allowing the case manager to select a neutral ")
- F. Computer system that offers dispute resolution through a third party mediator/arbitrator (column 19, lines 1-29), different from the disputing parties. The system guides the disputing parties through the process by allowing them to move seamlessly and uninterrupted through the process (column 19, lines 34-37)

- G. Receive indication of a selected neutral or third party i.e., mediator or arbitrator (column 19, lines 2-8)
- H. Allow third party to facilitate the dispute management process (column 19, lines 16-17) ("allowing the selected neutral to facilitate the dispute resolution process between the user and the at least one party using a third computer ")
- I. Have users as plaintiffs/claimants or defendants/respondents (column 4, line 42)
- J. Provide users with means to input registration data. This is equivalent to completing an on-line application form (column 9, lines 20-25) ("providing the user with access to a case filing application in response to receiving the indication from the user to filing file a claim")
- K. Receive request for and provide certain features of the dispute resolution management system (column 19, lines 43-47) ("the indication indicates a dispute management feature for the dispute management application ")
- L. Provide users access with dispute management related information. Users can use electronically search the system using key words to find relevant information (column 19, lines 52-67) ("providing the user with access to information relating to dispute management "); ("allowing the user to electronically search through the information"); ("wherein allowing the user to electronically search comprises receiving a keyword from the user")
- M. Provide users with contact information (e-mail) for mediators/arbitrators (column 5, lines 38-42)

- N. Provide on-line (documents only) or off-line mediation/arbitration (on-call) (column 5, lines 7-9). For online mediation/arbitration, all relevant documents can be transmitted electronically (column 5, lines 29-30, 39-40). For off-line mediation/arbitration, some of the relevant documents can be sent be transmitted, on-line; the rest of the transmission can be done via fax, phone or video (column 5, lines 31-33 & 41-43). ("providing the user with a directory, wherein the directory includes contact information")
- O. Provide users with access to mediators/arbitrators, if users choose this particular option (column 17, line 36-40)
- P. Provide users with additional information regarding the mediator/arbitrator officers (column 20, lines 44-52)
- Q. Receive dispute information from users (column 17, lines 5-7)
- R. Allow users to submit claim information (column 17, lines 5-7 & 44-50)
- S. Users can prioritize the viewing of their disputes, based on urgency level (column 18, lines 5-14)
- T. Provide dispute information to mediators/arbitrators (column 5, lines 24-31)
- U. Provide users with a preset period of time before the system logs them off (column 20, lines 65-66)
- V. Provide notifications to the arbitrators/mediators (column 17, lines 41-42)
- W. Provide users with discussion area for dispute related discussions via chat rooms and bulletin boards (column 4, line 14)
- X. Provide users access to disputes that they have submitted (column 19, lines 43-44)

- Y. Display all relevant information such as status or any recent activity (postings) of a dispute (column 22 lines 63-65)
- Z. Receive information from users regarding opposing parties or parties that have a conflict of interest with the dispute (column 16, lines 47-50)
- AA. Allow users to create profiles (column 4, lines 37-38). The data for a particular profile can be stored and retrieved by users (column 28, lines 31-37) for the purpose of dispute prevention. The data can also be used for dispute resolution (column 4, lines 55-58)
7. Although Israel teaches a system that guides the user the process, Israel did not explicitly teach a system in which another user provides guidance/management or support to a dispute resolution system. However, Landry et al. describe an invention that relates to alternative dispute resolution ("ADR") services and, in particular, to a computer-implemented system and method of providing online dispute resolution ("ODR") services over a computer network. Landry describes a system in which a clerk monitors the system processes using monitoring service; this service enables the Clerk to verify the validity of the Arbitration/Mediation Clause (discussed below), and to generally provide support to parties during ODR processes (e.g., providing assistance in completing and submitting electronic forms. The Clerk accepts the registration of mediators and arbitrators 128 into the ODR System 60 using the arbitrator/mediator enrollment service (par. 30). The clerk, as described by Landry, performs the similar functions to the case manager described in the claimed invention.
8. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would employ a method/system in which

another user provides guidance/management or support to a dispute resolution system. It would have been obvious to do so because it would provide the added benefit of having a human agent providing support and assistance to online system, which sometimes highly desirable by users of online or Internet systems.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 13-14, 72-73 and 131-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 6,766,307 B1) and Landry et al. (U.S 20030014265), in view of Murray et al. (U.S 5,023,851).

11. As per claims 13-14, 72-73 and 131-132, Israel et al. discloses a dispute resolution management method/system that can:

BB. Receive dispute resolution management request from users (column 2, line 44)

CC. Provide the options/features of the dispute resolution management from users
(column 3, lines 26-30)

DD. Manage the dispute resolution management techniques/process (column 5, lines
59-63)

EE. Receive indication of a selected neutral or third party i.e., mediator or arbitrator (column
19, lines 2-8)

FF. Allow third parties to facilitate the dispute management process (column 19, lines 16-17)

12. Israel and Landry did not explicitly describe a method/system in which the availability and selection of third party mediators/arbitrators is based on an on-line calendar. However, Murray et al describes a method for presenting electronic calendar information in an interactive information handling system, which employs a calendar program for displaying events and time slots available for the next event (column 9, lines 6-10). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would utilize an on-line calendar for the availability of mediators/arbitrators. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement an on-line, in order to minimize scheduling conflicts.

Conclusion

13. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

/Evens J. Augustin/
Evens J. Augustin
October 26, 2007
Art Unit 3621